

REMARKS/ARGUMENTS

Applicants respectfully request further examination and reconsideration in view of the instant response. The claims remaining in the present application are Claims 1-23. Claims 1-23 are rejected. Claims 1, 10 and 17-23 are amended herein. No new matter has been added. Support for the claim amendments can be found at least at page 6, lines 17-24 and lines 33-34.

CLAIM REJECTIONS – 35 U.S.C. §101

Claims 17-23

Claims 17-23 are rejected under 35 U.S.C. §101 “as being directed to non-statutory subject matter” (Decision on Appeal mailed March 16, 2010, page 8). Applicants have amended Claims 17-23 to be directed towards patentable subject matter. For example, Claim 17 has been amended to recite “[a] computer-usable storage medium ...” Applicants understand “[a] computer-usable storage medium ...,” as claimed, does not encompass forms of computer program code being embodied on transitory propagating signals. Therefore, Applicants respectfully submit that Claims 17-23 are directed towards patentable subject matter, and thus overcome the rejection under 35 U.S.C. §101.

CLAIM REJECTIONS – 35 U.S.C. §102

Claims 1-5, 7, 8, 10-14, 16-21 and 23

The Final Office Action mailed December 15, 2006, indicates that Claims 1-5, 7, 8, 10-14, 16-21 and 23 are rejected under 35 U.S.C. §102(b) as being anticipated by

“the Casati reference,” hereinafter referenced as “Casati.” The Decision on Appeal also affirms this rejection. Applicants respectfully submit that the embodiments of the present invention as recited in Claims 1-5, 7, 8, 10-14, 16-21 and 23 are patentable over the Casati reference for at least the following rationale.

Claim 1 recites an embodiment of the present invention (emphasis added):

A method for performing a context-dependent service comprising:
 executing a composite service;
 utilizing a context repository to store context information for a user,
wherein said context information is automatically detected without requiring user interaction and wherein said context information is based on a present user location and wherein said automatically detected context information comprises up-to-date present user location;
 accessing said context information; and
 automatically incorporating said context information with said composite service.

Claims 10 and 17 recite similar embodiments. Claims 2-9, 11-16 and 18-23 that depend from independent Claims 1, 10 and 17, respectively, also include these embodiments.

MPEP §2131 provides:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ... “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

Applicants respectfully submit that Casati does not anticipate “said automatically detected context information comprises up-to-date present user location” as claimed (emphasis added). Applicants respectfully note that the Decision on Appeal states “[t]he name ‘FlyHigh’ can be considered the claimed user context information” (page 6). As a result, Applicants understand Casati to disclose the name “FlyHigh” as the user context information. Applicants do not understand the name “FlyHigh” to comprise up-to-date present user location,” as claimed. Therefore, Applicants respectfully submit that Casati does not anticipate “said automatically detected context information comprises up-to-date present user location” as claimed (emphasis added).

Applicants respectfully submit that Casati does not satisfy a *prima facie* case of anticipation under 35 U.S.C. §102(b). Therefore, Applicants respectfully submit that Casati does not anticipate the claimed embodiments of the present invention as recited in independent Claims 1, 10 and 17. Applicants respectfully submit that Casati also does not anticipate the additional claimed features of the present invention as recited in 2-9, 11-16 and 18-23 that depend from independent Claims 1, 10 and 17, respectively. Therefore, Applicants respectfully submit that Claims 2-9, 11-16 and 18-23 also overcome the rejection under 35 U.S.C. § 102(b), and are in a condition for allowance as being dependent on an allowable base claim.

CLAIM REJECTIONS – 35 U.S.C. §103(a)

Claims 6, 15 and 22

The Final Office Action states that Claims 6, 15 and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Casati in view of Stewart et al. (US 2002/0161688), hereinafter referenced as “Stewart.” The Decision on Appeal also affirms this rejection. Applicants respectfully submit that the embodiments of the present invention as recited in Claims 6, 15 and 22 are patentable over the combination of Casati and Stewart for at least the following rationale.

Claims 6, 15 and 22 are dependent on and include the features of independent Claims 1, 10 and 17, respectively. By demonstrating that the combination Casati and Stewart does not teach or suggest the features of independent Claims 1, 10 and 17, it is also demonstrated that the combination of Casati and Stewart does not teach or suggest the embodiments of dependant Claims 6, 15 and 22.

“As reiterated by the Supreme Court in *KSR*, the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Obviousness is a question of law based on underlying factual inquiries” including “[a]scertaining the differences between the claimed invention and the prior art” (MPEP 2141(II)). “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious” (emphasis in original; MPEP 2141.02(I)).

Applicants note that “[t]he prior art reference (or references when combined) need not teach or suggest all the claim limitations, however, Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art” (emphasis added; MPEP 2141(III)).

Moreover, Applicants respectfully note that “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention” (emphasis in original; MPEP 2141.02(VI); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)).

Applicants respectfully submit that Casati does not teach or suggest “said automatically detected context information comprises up-to-date present user location” as claimed. Applicants respectfully note that the Decision on Appeal states “[t]he name ‘FlyHigh’ can be considered the claimed user context information” (page 6). As a result, Applicants understand Casati to disclose the name “FlyHigh” as the user context information. Applicants do not understand the name “FlyHigh” to comprise up-to-date present user location,” as claimed. Therefore, Applicants respectfully submit that Casati does not teach or suggest “said automatically detected context information comprises up-to-date present user location” as claimed.

Moreover, Stewart does not overcome the deficiencies of Casati. Applicants understand Stewart to disclose “[a]n enterprise wide electronic commerce system

allows trading partners to act as participants in a complex trading process” (abstract). In particular, Stewart does not disclose “said automatically detected context information comprises up-to-date present user location” as claimed.

Applicants respectfully submit that the combination of Casati and Stewart, as a whole, does not satisfy a *prima facie* case of obviousness under 35 U.S.C. §103(a). Therefore, Applicants respectfully submit that Claims 1, 10 and 17 are in a condition for allowance. Applicants respectfully submit that the combination of Casati and Stewart also does not render obvious the additional claimed features as recited in Claims 6, 15 and 22 that depend on Claims 1, 10 and 17, respectively. Therefore, Claims 6, 15 and 22 are in a condition for allowance as being dependent on an allowable base claim.

Claim 9

The Final Office Action states that Claim 9 is rejected under 35 U.S.C. §103(a) as being unpatentable over Casati in view of Ramanathan et al. (US 6182136), hereinafter referenced as “Ramanathan.” The Decision on Appeal also affirms this rejection. Applicants respectfully submit that the embodiments of the present invention as recited in Claim 9 is patentable over the combination of Casati and Ramanathan for at least the following rationale.

Claim 9 is dependent on and includes the features of independent Claim 1. By demonstrating that the combination Casati and Ramanathan does not teach or suggest the features of independent Claim 1, it is also demonstrated that the combination of

Casati and Ramanathan does not teach or suggest the embodiments of dependant Claim 1.

Applicants respectfully submit that Casati does not teach or suggest “said automatically detected context information comprises up-to-date present user location” as claimed. Applicants respectfully note that the Decision on Appeal states “[t]he name ‘FlyHigh’ can be considered the claimed user context information” (page 6). As a result, Applicants understand Casati to disclose the name “FlyHigh” as the user context information. Applicants do not understand the name “FlyHigh” to comprise up-to-date present user location,” as claimed. Therefore, Applicants respectfully submit that Casati does not teach or suggest “said automatically detected context information comprises up-to-date present user location” as claimed.

Moreover, Ramanathan does not overcome the deficiencies of Casati. Applicants understand Ramanathan to disclose “[a] method and system for modeling services available via a network” (abstract). In particular, Ramanathan does not disclose “said automatically detected context information comprises up-to-date present user location” as claimed.

Applicants respectfully submit that the combination of Casati and Ramanathan, as a whole, does not satisfy a *prima facie* case of obviousness under 35 U.S.C. §103(a). Therefore, Applicants respectfully submit that Claim 1 is in a condition for allowance. Applicants respectfully submit that the combination of Casati and

Ramanathan also does not render obvious the additional claimed features as recited in Claim 9 that depends on Claim 1. Therefore, Claim 9 is in a condition for allowance as being dependent on an allowable base claim.

CONCLUSION

In light of the above remarks, Applicants respectfully request reconsideration of the rejected claims.

Based on the arguments presented above, Applicants respectfully assert that Claims 1-23 overcome the rejection of record, and therefore Applicants respectfully solicit allowance of these claims.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,

WAGNER BLECHER LLP

Date: May 17, 2010

/John P. Wagner, Jr./
John P. Wagner, Jr.
Reg. No. 35,398
123 Westridge Drive
Watsonville, CA 95076 USA
(408) 377-0500